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OFFICE OF PETITIONS

In re Application of	:	
Yoshinari Morimoto	:	DECISION ON PETITION TO
Application Number: 10/625778	:	WITHDRAW HOLDING OF
Filing Date: 07/24/2003	:	ABANDONMENT
Attorney Docket Number: 116571	:	

This is a decision on the petition to withdraw the holding of abandonment filed on February 3, 2009.

The petition is **GRANTED**.

On November 26, 2008, a decision by the Board of Patent Appeals and Interferences was rendered, affirming the examiner's decision rejecting the appealed claims.

On January 26, 2009, a Request for Continued Examination (RCE) was filed, along an amendment as the required submission under 37 CFR 1.114. The RCE fee was also paid.

On January 27, 2009, a Notice of Abandonment was mailed, stating that the application was abandoned because the period for seeking court review of the decision had expired and there are no allowed claims.

On February 3, 2009, the present petition was filed, accompanied by a copy of the RCE and submission.

Petitioners assert, in the present petition, that the Notice of Abandonment was mailed in error, as the RCE and submission were timely filed in response to the board decision.

Upon review, petitioners' argument is well taken.

MPEP 706.07(h) section (XI)(A) states in pertinent part that the filing of an RCE (accompanied by the fee and a submission) after

a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit (Federal Circuit) or the commencement of a civil action in federal district court, will result in the finality of the rejection or action being withdrawn and the submission being considered. Generally, the time period for filing a notice of appeal to the Federal Circuit or for commencing a civil action is within two months of the Board's decision. See 37 CFR 1.304¹ and MPEP § 1216. Thus, an RCE filed within this two month time period and before the filing of a notice of appeal to the Federal Circuit or the commencement of a civil action would be timely filed.

Furthermore, 37 CFR 1.198 states:

When a decision by the Board of Patent Appeals and Interferences on appeal has become final for judicial review, prosecution of the proceeding before the primary examiner will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.114 or § 41.50 of this title without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

As such, applicant was entitled to a two (2) month time period after the date the board decision was mailed to file a response to the board decision.

As such, the showing of record is that the RCE and submission under 37 CFR 1.114 filed on January 26, 2009, were a timely and proper response to the board decision mailed on November 26, 2008.

Therefore, there is no abandonment in fact. The holding of abandonment is withdrawn. The Notice of Abandonment is vacated.

¹ 37 CFR 1.304(a) states:

(1) The time for filing the notice of appeal to the U.S. Court of Appeals for the Federal Circuit (§ 1.302) or for commencing a civil action (§ 1.303) is two months from the date of the decision of the Board of Patent Appeals and Interferences. If a request for rehearing or reconsideration of the decision is filed within the time period provided under § 41.52(a), § 41.79(a), or § 41.127(d) of this title, the time for filing an appeal or commencing a civil action shall expire two months after action on the request.

The application is referred to Technology Center Art Unit 2853 for further processing.

Telephone inquiries concerning this matter may be directed to the undersigned at (571)272-3231.

A handwritten signature in black ink, appearing to read "D. Wood", is positioned above the printed name.

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions